

REMARKS

As previously noted, pending claims 16-23 correspond to originally filed pharmaceutical composition claims 1-8 (except that the pending claims are directed to the compounds *per se* instead of pharmaceutical compositions comprising them); and claims 24-28 correspond to originally filed claims 11-15. Pharmaceutical composition claims 29 and 30 are intended to be identical in scope to originally filed claims 1 and 12.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 16-30 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors possessed the invention at the time the instant application was filed.

Specifically, the statement of the rejection asserts that the instant application “fails to provide support for tautomeric forms of ring A, B, C and D”. Applicants have carefully reviewed the claims and the specification and respectfully traverse because no *prima facie* case of “new matter” has been presented.

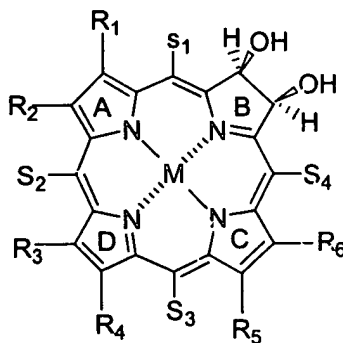
As an initial matter, Applicants wish to point out that pending claims 24-26 and 28 are directed to the same compounds as those found within the scope of claims 11-13 and 15 as originally filed. This is particularly relevant to claim 26, which is an independent claim directed to specific compounds disclosed in the application without reliance upon the representation of rings A through D.

Similarly, claims 24, 25 and 28 relate to specific compounds without reliance upon the representation of rings A through D. Therefore, Applicants respectfully submit that at least with respect to claims 24-26 and 28, no *prima facie* case of “new matter” has been presented.

With respect to the remaining claims, Applicants respectfully point out that a comparison of pending claim 16 and previous claim 1 demonstrates that claim 1 and the specification as filed provide support for claim 16. First, and with respect to subportion i) of claim 16, the Examiner’s attention is respectfully directed to the fact that the representative structure for ring A is

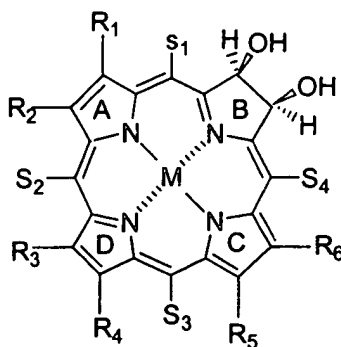
identical to that of the first possibility for ring A in claim 1 as originally filed. The Examiner's attention is also directed to the fact that the three representative structures for ring D in subportion i) are identical to the three possibilities for ring D in claim 1 as originally filed. The structures shown for rings B and C are simply representations of those rings to render them consistent with the representations of rings A and D. Subportion i) contains no new matter and is clearly supported by claim 1 as originally filed.

As noted in the preceding paragraph, the formulas shown for the various rings are merely representative of electron positions in a compound of formula (I) as presented in originally filed claim 1 and in formula (I) of claim 16. As such, and to assist the Examiner, the first possibilities for rings A and D can be combined with formula (I) and the representations of rings B and C to produce the following representation A:



This representation is fully within the scope of formula (I) in claim 1 as originally filed.

But as would be clear to the skilled artisan at the time the instant application was filed, representation A only demonstrates one possible arrangement of the electron positions because the double bonds are conjugated, and so the electrons are actually disseminated around the larger tetrapyrrolic ring. To assist in the ability to represent this, art recognized adoption of "tautomeric form" representations of compounds is used. Thus the above representation can also be shown as the following representation B:



Simply put, there is no new matter in representation B because it shows the identical chemical compound as that represented by representation A above. Because it is the claimed subject matter which must be supported by the original disclosure of the invention, there is no new matter in representation B. To hold otherwise would be to require every possible tautomeric form of a claimed compound to be explicitly recited in an application. Applicants respectfully submit that this is not the standard.

A simple comparison of representation B and the subportion ii) of pending claim 16 shows how the ring A and ring D portions of representation B are the first possibilities for rings A and D in the subportion of the claim. The ring B and C portions of representation B are identical to rings B and C in the subportion of the claim.

Turning to the second and third possibilities for ring A in subportion ii) of claim 16, the Examiner's attention is respectfully directed to the fact that these possibilities simply represent ring A in the reduced form as found in structures 70 and 71 in Figure 8. Similarly, the second and third possibilities for ring D in subportion ii) of claim 16 simply represent ring D in the reduced form as found in the second and third possibilities for ring D in structure 66 in Figure 6 and structures 67 and 68 in Figure 7.

In light of the above, no new matter has been introduced by way of claim 16. Applicants respectfully request that the rejection be withdrawn.

Conclusion


In light of the above discussion and new claims, Applicants respectfully request that no prima facie case of "new matter" has been presented, and claims 16-30 are supported by the

application as filed. In the event the Examiner finds that a telephonic discussion may be helpful to address any residual issue, she is respectfully invited to contact the undersigned.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 273012011200. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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